

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRYSTAL A. SMITH

Appeal No. 95-2080
Application 08/053,965¹

ON BRIEF

Before WARREN, OWENS and LIEBERMAN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 5 through 9 and refusing to allow claims 1 through 4 and 10 through 13 as amended subsequent to the final rejection.² Claims 14 through 20 are also of record and have been withdrawn from

¹ Application for patent filed April 27, 1993. According to appellant, this application is a continuation of application 07/423,293 (application ‘293), filed October 18, 1989, now abandoned.

² Appellant presented two amendments subsequent to the final rejection of August 5, 1993 (Paper No. 21). The amendment of November 12, 1993 (Paper No. 22) presented *claims 1 and 5* in amended form as required by 37 CFR § 1.121(b). This amendment was *denied entry* by the examiner in his advisory action of November 16, 1993 (Paper No. 23). The amendment of December 1, 1993 (Paper No. 25) presented *only claim 1* in amended form as required by 37 CFR § 1.121(b). This amendment

consideration by the examiner pursuant to 37 CFR § 1.142(b).

We have carefully considered the record before us, and based thereon, find that we cannot sustain the ground of rejection of claims 1 through 13 under 35 U.S.C. § 103 over Mizogami in view of Ausimont, Kashiwa and Kurz.³ It is well settled that the examiner may satisfy his burden of establishing a *prima facie* case of obviousness under § 103 by showing some objective teachings or suggestions in the prior art taken as a whole or that knowledge generally available to one of ordinary skill in the art would have led that person to arrive at the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellant's disclosure. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 1074-1076, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988); *In re Warner*, 379 F.2d 1011, 1014-17, 154 USPQ 173, 176-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). However, the examiner has failed to make out a *prima facie* case of obviousness as to the claimed invention as whole encompassed by claims 1 through 13 since he has not provided evidence and/or scientific reasoning in the record why one of ordinary skill in this art would have modified Mizogami with the teachings of Ausimont and Kurz (answer, pages 2-3 and 4-5) or, in an embedded combination of references, would have modified Ausimont with the teachings of Kashiwa and also of Mizogami (answer, pages 3-4) in order to arrive at the solid catalyst components, the methods of making solid

was *entered* upon the filing of an appeal by the examiner in his advisory action of December 8, 1993 (Paper No. 27). The examiner did not appropriately mark either of the amendments with respect to whether the same should be entered. *Both* amendments were clerical entered wherein the *claim 1* as presented in the amendment of December 1, 1993, was canceled in favor of *claim 1* as presented in the amendment of November 12, 1993, and the amendment of November 12, 1993 was entered with respect to both *claims 1 and 5*. Based on the decisions of the examiner with respect to the entry of these amendments as set forth in his advisory actions, the claims properly before us in this appeal are *claim 1* as presented in the amendment of December 1, 1993, and *claim 5* as presented in the amendment of November 6, 1992 (Paper No. 15 of application '293).

³ The references relied on by the examiner are listed at page 2 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

catalyst components and catalysts containing the solid catalyst components encompassed by the appealed claims.

Indeed, it is apparent that the scope of the appealed claims has changed over the course of the prosecution in the present and '293 applications. We find that claim 1, couched in product-by-process format, requires at least that an activated *anhydrous MgCl₂/alcohol adduct* solid support is *first* treated with a *combination* of a specified titanium halide at least one halogen containing Hf, Zr or Sc compound *and then* treated at least once with one specified titanium halide, halogen containing Hf, Zr or Sc compound or a combination thereof in order to arrive at the claimed solid catalyst component. Appellant discloses in the specification (e.g., page 6) that the manner in which the activated anhydrous MgCl₂/alcohol adduct solid support is treated with the specified transition metal halide compounds affects the activity of the catalyst. Thus, as a basic consideration, none of the references taken singularly or as applied in either combination by the examiner, teaches or suggests a schedule for the treatment of an activated anhydrous MgCl₂/alcohol adduct solid support with transition metal halide compounds as specified in claim 1, such that it is inescapable that the references as combined by the examiner taken as a whole would not have resulted in the claimed solid catalyst component.⁴

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). Thus, it is manifest that the only direction to appellants' claimed invention as a whole on the record before us is supplied by appellants' own specification.

The examiner's decision is reversed.

Remand To The Examiner

This application is remanded to the examiner to consider whether claims 2 through 4 find

⁴ Our consideration of claim 1 is sufficient to dispose of the issues presented by the applied prior art in this appeal with respect to all of the appealed claims even though we note that product claim 1 and process claim 5, as they stand on appeal (*see supra* note 2), are of different scope with respect to limitations on process conditions and thus to the products prepared. We observe that claims 10 through 13 are drawn to catalysts containing the solid catalyst components of claims 1 through 4, respectively.

antecedent basis in and further limit claim 1 and whether claims 6, 8 and 9 find antecedent basis in and further limit claim 5, as claims 1 and 5 now stand of record (*see supra* note 2), as required by 35 U.S.C. § 112, second and fourth paragraphs.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (7th ed., July 1998).

REVERSED and REMANDED

CHARLES F. WARREN
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

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